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REMARKS

I. Corrected Listing of Claims

In addition to the amendments to the claims described herein, the present listing of claims also rectify certain inadvertent and obvious errors that were present in previously-filed listings of claims.¹ In these previous listings:

a) originally-filed claim 2 was inadvertently and unintentionally omitted,

b) originally-filed claims 3-26 were inadvertently and unintentionally renumbered as claims 2-25, respectively, and

c) claim 25 was inadvertently and unintentionally duplicated as claim 26.

Where necessary, these errors have now been corrected in the present listing of claims. In particular,

(a) misnumbered claims 2-12, 14, 15, and 17 have been restored to their original numbering as claims 3-13, 15, 16, and 18, respectively, and (b) originally-filed claim 2 has been restored.

These corrections merely restore the numbering of the pending claims in accordance with those originally filed, and therefore do not introduce new matter into this application and are not amendments to the claims. In this paper, the corrected claim numbers will be used.

¹ The previously-filed listing of claims were submitted with papers filed in this application on August 29, 2003; November 11, 2003; and November 18, 2005.

II. Status of the Claims

Claims 1-13, 15, 16, 18, 50-59, 62-66, 98-107, 110-114, and 146-157 were pending in this application.

Claims 1, 50, 98, and 146-148 are amended herein. Support for these amendments can found in the applicant's specification and claims as originally filed, particularly at, for example, page 5, lines 11-20; page 9, lines 1-10; and page 25, lines 28-30. Applicant requests their entry.

III. Summary of the Rejections

Claims 1-4, 6-13, 15, 18, 50, 52, 54-59, 62-65, 98-107, 111, 112, and 146-157 were rejected under 35 U.S.C. § 103(a) as being unpatentable over LaJoie (U.S. Patent 5,850,218) in view of Walter (U.S. Patent 4,506,387).

Claims 16, 51, 110, 113, and 114 were rejected under 35 U.S.C. § 103(a) as being unpatentable over LaJoie in view of Walter and several allegedly well-known program guide features.

Claims 5 and 53 were rejected under 35 U.S.C. § 103(a) as being unpatentable over LaJoie in view of Walter in further view of Dunn (U.S. Patent 6,571,390). Claim 66 was rejected under 35 U.S.C. § 103(a) as being unpatentable over LaJoie in view of Walter in further view of Yates (U.S. Patent 6,330,586).

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These rejections are respectfully traversed.

IV. Rejections Under 35 U.S.C. § 103

A. Independent Claims 1, 50, 98, and 146-148

Applicant's claims are directed to an interactive television program guide system which includes "a partial screen program guide display" that displays "at least one video-on-demand program listing." The system allows a viewer to select a video-on-demand (VOD) program listing or order a VOD program associated with a listing. The interactive television program guide then displays immediately the VOD program that is selected or ordered by the viewer.

Independent claims 1, 50, and 98 have been amended herein in two respects to more particularly point out and distinctly claim applicant's invention. First, to make clear that the VOD program listings displayed in the partial screen program guide display are selectable by the user. Second, to make clear that the VOD program listings displayed in the partial screen program guide display represent VOD programs that are available for immediate display when selected by the viewer. Similarly, independent claims 146-148 have also been amended to make clear that the VOD program listings displayed in the partial screen program guide display represent VOD programs that are available for immediate display when ordered by the viewer.

For at least the following reasons, applicant submits that LaJoie and Walter do not disclose or suggest, either

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expressly or inherently, all of the features of applicant's invention as set forth in claims 1, 50, 98, and 146-148.

LaJoie Does Not Show or Suggest Allowing Selection Of A VOD Program Listing Or Allowing Ordering Of A VOD Program Associated With A VOD Program Listing

Applicant submits that the figures in LaJoie relied on by the Examiner to support the rejections clearly lack certain features of applicant's invention as set forth in amended claims 1, 50, 98, and 146-148.

The Examiner contends that display 508 in FIG. 25 of LaJoie discloses "at least one VOD listing." (Office Action at pages 3 and 8.) However, this illustration merely depicts program information about a pay-per-view (PPV) program that is being displayed (e.g. title of the PPV program, channel, elapsed time). Indeed, LaJoie refers only to PPV programming in this display, and not VOD programming.

Furthermore, this program information of LaJoie does not even include the same features as applicant's VOD program listing, because (1) LaJoie does not show or suggest that this PPV program information allows the viewer to select at least one of the VOD program listings (as per amended claims 1, 50, and 98), and (2) LaJoie does not show or suggest that this PPV program information allows the viewer to order a VOD program associated with at least one VOD program listing (as per amended claims 146-148).

Indeed, LaJoie makes clear that such features would be unnecessary. In particular, LaJoie makes clear that a "purchasing" of the PPV program had already taken place in other prior screens (LaJoie at FIG. 25, 496 and 502; column 29, lines 36-55), and thus display 508 is merely displaying the program information of the purchased PPV program. Having already purchased the PPV program, there would have been no reason to allow a user to select a VOD program listing or order a VOD program in display 508.

LaJoie Does Not Show or Suggest A Partial-Screen Program Guide While Displaying A Television Program

Likewise, FIG. 29, as cited by the Examiner, also does not disclose applicant's partial screen program guide display as set forth in amended claims 1, 50, 98, and 146-148. Applicant's claimed invention requires a partial screen guide displayed on the viewer television equipment at the same time that a given television program is displayed. However, LaJoie refers to screen 564 of FIG. 29 as an "interactive barker," but there is no disclosure or suggestion that this interactive barker is displaying a partial screen program guide while displaying a given television program at the same time.

Instead, the Examiner has assumed that the picture shown in this figure corresponds to a television program being displayed at the same time as a partial screen program guide. However, LaJoie provides no support for this assumption. To the contrary, similar screens in FIGS. 28 and 30 (544 and 556 in FIG. 28; 544, 556 and 586 in FIG. 30) suggest that this picture is merely part of the description of the PPV program being

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offered to the viewer, and not a television program being displayed at the same time as a partial screen program guide. Therefore, applicant submits that the Examiner has also misconstrued FIG. 29 of LaJoie.

LaJoie Does Not Inherently
Disclose VOD Program Listings

Furthermore, LaJoie also does not show a partial screen program guide display that expressly includes at least one VOD program listing that is available for immediate display to the viewer. The displays cited by the Examiner refer only to pay-per-view (PPV) programming (see, e.g., LaJoie at FIGS. 25 and 29) or broadcast programming. The Examiner concedes this lack of express disclosure by contending that LaJoie "inherently includes means for displaying VOD program listings." (Office Action at pages 3 and 8; emphasis added.) To support this contention, the Office Action relies on a "channel look-up table" that refers to a particular channel being "associated with a VOD service." (LaJoie at FIG. 5 and column 16, lines 10-51.)

Applicant submits that the mere reference to a "VOD service" in LaJoie is insufficient to support the contention that VOD program listings are inherently disclosed in LaJoie. Indeed, applicant respectfully submits that the Examiner has not provided the requisite "rationale or evidence tending to show inherency" of VOD program listings in LaJoie. (MPEP § 2112.) Specifically, it has not been established that VOD listings are "necessarily present in the thing described in the

reference, and that it would be recognized by persons of ordinary skill." (MPEP § 2112, citing *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999); emphasis added.)

Not only are VOD program listing not inherently disclosed in LaJoie, applicant submits that LaJoie teaches away from any such inherent disclosure. VOD programming is different than either broadcast or pay-per-view (PPV) programming. VOD programs "consist of a library or database of programs that are available at any time for viewing," and thus viewers may "watch the [VOD] programs contained in the database at virtually any time." (Specification at page 2, lines 5-7, 14-16.) As a result, VOD programs can be selected or ordered by the viewer without regard to start time or channel, and are available for immediate display to the viewer. In contrast, both broadcast and PPV programming are associated with specific start times and channels, both of which are pre-scheduled.

In accordance with this principle, in FIGS. 25 and 29 of LaJoie, the PPV-related displays refer to information necessary for ordering PPV programs, such as pre-scheduled, specific channels (e.g., "75", "CH#", "CHANNEL 75") and pre-scheduled, specific start times (e.g., "TIME", "8:00-10:00", "DAY/DATE", "8:00PM M 9/16") of the PPV programs. However, as discussed above, neither pre-scheduled start times nor pre-scheduled channels are required for ordering or selecting VOD programs. Therefore, applicant submits that LaJoie's displays are clearly unsuitable for allowing a viewer to select or order VOD programs and, moreover, LaJoie provides no disclosure or suggestion how to modify these displays to overcome this unsuitability.

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Applicant submits that LaJoie neither discloses nor suggests how its PPV or broadcast program guide displays could be used or modified for ordering VOD programs or selecting VOD program listings. As a result, partial screen program guide displays with VOD program listings in the manner of applicant's claimed invention could not be "necessarily present" in LaJoie. At best, LaJoie could provide VOD programming in full-screen program guide displays as in conventional prior systems, but not the partial screen program guide displays in the manner of applicant's approach. (see, e.g., applicant's specification at page 7, line 11 to page 8, line 31; FIGS. 1A-1C.)

For at least these reasons, applicant submits that the Examiner's contention that VOD program listings are inherently disclosed in LaJoie is unsupported and, indeed, LaJoie teaches away from such a feature. Therefore, partial screen program guide displays with VOD listings in the manner of applicant's claims 1, 50, 98, and 146-148 are neither disclosed nor suggested by LaJoie, either expressly or inherently. In addition, as discussed above, LaJoie also does not disclose or suggest other required features of applicant's invention, such as allowing a viewer to select a VOD program listing, or allowing a viewer to order a VOD program associated with a VOD program listing.

Furthermore, these deficiencies of LaJoie are not compensated by any disclosure or suggestion of Walter. For at least these additional reasons, applicant request that the rejections of independent claims 1, 50, 98, and 146-148 over LaJoie and Walter be withdrawn.

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B. Claims 2-13, 15, 16, 18, 51-59,
 62-66, 99-107, 110-114, 149-157

Claims 2-9, 11-13, 15, and 16 are allowable at least for the reasons that claim 1 is allowable. Claims 51-57, 59, 63-66 are allowable at least for the reasons that claim 50 is allowable. Claims 99-105, 107, and 111-114 are allowable at least for the reasons that claim 98 is allowable. Claims 10, 18, and 149-151 are allowable at least for the reasons that claim 146 is allowable. Claims 58, 62, and 152-154 are allowable at least for the reasons that claim 147 is allowable. Claims 106, 110, and 155-157 are allowable at least for the reasons that claim 148 is allowable. Applicant therefore requests that these rejections be withdrawn.

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CONCLUSION

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The foregoing demonstrates that all of the pending claims are patentable and are in condition for allowance. Reconsideration and allowance of the application is respectfully requested

Respectfully submitted,



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